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09/878,719	06/11/2001	Roger Minkow	SPECBIC.017C3	2793

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EXAMINER

Barfield, Anthony Derrell

ART UNIT	PAPER NUMBER
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3636

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Paper No. 20

Application Number: 09/878,719
Filing Date: June 11, 2001
Appellant(s): MINKOW ET AL.

MAILED

MAY 06 2003

GROUP 3600

Edward A. Schlatter
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed February 10, 2003 .

(I) Real Party in Interest

A statement identifying the real party in interest is contained in the brief.

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(2) *Related Appeals and Interferences*

The brief does not contain a statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief. Therefore, it is presumed that there are none. The Board, however, may exercise its discretion to require an explicit statement as to the existence of any related appeals and interferences.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

No amendment after final has been filed.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is substantially correct. The changes are as follows: C. Whether claim 26 is properly rejected under 35 U.S.C. 103 (a) as being unpatentable over Henderson.

D. Whether claim 26 is properly rejected under 35 U.S.C. 103 (a) as being unpatentable over Plus Advertisement.

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(7) *Grouping of Claims*

The rejection of claims 25 and 26 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) *Prior Art of Record*

576,310

HENDERSON

2-1897

"PLUS seat Advertisement" from Photocopy of ISCA Components Accessori per ciclo product brochure 1997.

(10) *Grounds of Rejection*

The following ground(s) of rejection are applicable to the appealed claims:

Claim 25 is rejected under 35 U.S.C. 102(b) as being clearly anticipated by Henderson. Henderson discloses a seat comprising a rigid frame (e) and resilient padding layer having a beveled central groove see Figures 2 and 3. The groove extends to inherently form a scrotum channel as it narrows from a back end of the frame to a front end of the frame.

Claim 25 is rejected under 35 U.S.C. 102(b) as being clearly anticipated by Plus (bicycle seat advertisement). Plus discloses a seat comprising a rigid frame (see photocopy of ISCA Components Accessori) and resilient padding layer having a beveled central groove. The groove extends to inherently form a scrotum channel as it narrows from a back end of the frame to a front end of the frame.

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Claim 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over Henderson. Henderson shows all of the teachings of the claimed invention except the use of a groove having an one inch width at a location midway between the front end and back end of the frame. It would have been an obvious matter of design choice to modify the groove with a width of approximately one inch, since such a modification would have involved a mere change in size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. In re Rose (CCPA 1955).

Claim 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over Plus. Plus shows all of the teachings of the claimed invention except the use of a groove having an one inch width at a location midway between the front end and back end of the frame. It would have been an obvious matter of design choice to modify the groove with a width of approximately one inch, since such a modification would have involved a mere change in size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. In re Rose (CCPA 1955).

(11) Response to Argument

In response to appellant's argument that Henderson does not teach a "*frame defining a first support surface at said front end of saddle ...generally widening from front to back*", the examiner is of the position that in fact Henderson does teach the claimed frame so far as defined. Henderson shows a frame (e) bent from wire, which forms a first support surface (the top surface of the bent wire), which extends "perimetrically" from a first outer side continuously to a second outer side and "**generally**" widens from a front to back.

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In response to appellants' arguments that the groove of , *"Henderson is too narrow and is thus inadequate to meet the limitation of Claim 25"* and *"the groove of the Plus is not configured to provide the advantages of the claimed invention"*, appellant's arguments amount to a **general allegation** that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references. The examiner is of the opinion that the grooves as shown by both Henderson and the Plus are of sufficient size to inherently provide *"an open space for relieving pressure on the pudendal arteries"* of a particular user depending on the size of the user's genital region.

In response to appellant's arguments that the *"Henderson does not show all of the teachings of the claimed invention except the use of a groove having a one inch width at a location midway between the front end and back end of the frame"*, appellant is referred to the above argument with respect to the frame. Appellant is reminded that claim 26, recites "said groove is **approximately** one inch wide at a location midway between said front end and said back end", and the examiner is of the opinion that the groove of Henderson is "approximately" one inch however it would have been matter of design choice to modify the groove with a width of approximately one inch at a location between the front end and back end. Appellant should further note that the claim 26 **did not positively** state that the groove is one inch but only "approximately" one inch and a groove which is "half an inch wide" is "approximately" one inch upon rounding up to the nearest inch.

In response to appellant's argument that *"Plus does not teach at least a groove extending to form a scrotum channel to relieve pressure on the pudendal arteries"*, a recitation of the intended use of the claimed invention must result **in a structural difference** between the

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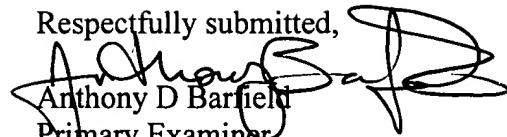
claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

The examiner has carefully considered the declaration and is of the position that the declaration is reflection of the appellant's opinion, which is unsubstantiated by a showing of evidence to verify the benefits of having an one inch groove versus a groove having a half or three-quarters inch width. Appellant's referral to the declaration by Dr. Minkow in that "*the ISCA Plus advertisement has a cutout /groove that is far too narrow and too shallow to provide the benefits*", amounts to a general allegation to the patentability of the claimed invention and is not supported by any clear evidence of an unforeseen result which would support "an approximately one inch groove" and its benefits versus the benefits of a groove, as taught by the Plus seat.

For the above reasons, it is believed that the rejections should be sustained.

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Respectfully submitted,


Anthony D Barfield
Primary Examiner
Art Unit 3636

adb

May 2, 2003

Conferees

PC


PB



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